

Practitioner's Docket No. U 013838-2

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 14 2004

In re application of: Kazuhide KUBOTA, et al

Application No.: 10/056,231

Group No.: 1714

Filed: January 25, 2002

Examiner: Manish S. Shah

For: RECORDING METHOD FOR
PRINTING USING TWO LIQUIDS
ON RECORDING MEDIUM

Date of mailing "Notice of Allowance and Base
Issue Fee Due" May 5, 2004

Batch No. 6911

OFFICE OF PETITIONS

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Attention: Office of Petitions

[x] SPECIAL PROCEDURES SUBMISSION

NOTE: Any petition to withdraw an application from issue after payment of the issue fee should be either submitted by facsimile or hand-carried to the Office of Petitions, M.P.E.P., 8th Edition.

WARNING: Petitions for express abandonment of patent applications after payment of the issue fee is decided in the Office of the Deputy Commissioner for Patent Examination Policy, M.P.E.P., 8th Edition.

PETITION FOR WITHDRAWAL FROM ISSUE

—ISSUE FEE PAID (37 C.F.R. § 1.313(c))

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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37 C.F.R. 1.8(a)

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06/15/2004 AKELLEY Date: 00000001 10056231

02 FC:1801

770.00 DP

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

NOTE: "Paragraph (a) of § 1.56 states that the duty to disclose information exists until the application becomes

abandoned. The duty to disclose information, however, does not end when an application becomes allowed but extends until a patent is granted on that application. The rules provide for information being considered after a notice of allowance is mailed and before the issue fee is paid (Section 1.97(d)) and for an application to be withdrawn from issue after the issue fee has been paid. An application may be withdrawn from issue because one or more claims are unpatentable. . . or an application may be withdrawn from issue and abandoned so that information may be considered in a continuing application before a patent issues. . ." Notice of January 9, 1992, 1135 O.G. 13-25 at 16.

NOTE: If an application is withdrawn from issue. . . , an information disclosure statement can be submitted in the continuing application under § 1.97(b) without a certification. A continuing application is treated like any other application with regard to the times set forth in § 1.97(b). Thus, for example, an information disclosure statement could be filed without a fee or certification in a continuing application within three months of the filing date of the continuing application. Notice of January 9, 1992, 1135 O.G. 13-25, at 21.

NOTE: "It would not be proper to make final a first Office action in the continuing application if the information submitted is used in a new ground of rejection." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: If the petition is made [§ 1.313(c)(1)], that one or more claims are unpatentable, then the Notice of April 20, 1992 (1138 O.G. 37-41) states:

"This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 C.F.R. § 1.313(c)(1)."

NOTE: "The Office will consider [the filing of a petition to permit consideration of an information disclosure statement under § 1.97 in a continuing application]. . . as sufficient grounds to waive the requirement that [a continuing] application . . . be filed before payment of the issue fee." Notice of April 20, 1992 (1138 O.G. 37-41,40).

PETITION

1. Applicant hereby petitions for the withdrawal of this application from issue.

PATENT ISSUE FEE

2. The issue fee for this case was paid on April 22, 2004.

(complete the following, if known)

This application is scheduled to

☐ issue on _____

☐ as patent _____

REASON(S) FOR WITHDRAWAL REQUEST

3. The reason for withdrawal from issue of this application is for consideration of an information disclosure statement in a continuing application. 37 C.F.R. §. 1.313(c).

(a) ☐ unpatentability of a claim

(b) ☒ RCE

(c) ☐ Express Abandonment

EXPRESS ABANDONMENT

4. ☐ Accompanying this petition is an express abandonment of this application to be effective on the grant of this petition and when the continuing application is granted a filing date so as to make this application copending with the continuing application.

FILING OF RCE

5. ☒ A Request for Continued Examination

☐ was filed on _____.
☒ is being filed on the same date as this petition.
☒ These papers accompany this petition.

6. **PETITION FEES** (37 C.F.R. § 1.17(i))

The petition fee set forth in § 1.17(h), required by 37 C.F.R. § 1.313(a) is paid as follows:

☒ Attached is a check in the amount of \$ 130.00
☐ Authorization is hereby made to charge the amount of \$ 130.00
to Deposit Account No. 12-0425

☒ Charge any additional fees required by this paper or credit any overpayment to deposit account 12-0425.

Reg. No. 30,086

Tel. No.: (212) 708-1890

Customer No.: 00140



SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kazuhide KUBOTA, et al
Application No.: 10/056,231 Group No.: 1714
Filed: January 25, 2002 Examiner: Manish S. Shah
For: RECORDING METHOD FOR PRINTING USING TWO LIQUIDS ON RECORDING
MEDIUM

Attorney Docket No.: U 013838-2

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUN 14 2004

OFFICE OF PETITIONS

PETITION UNDER 37 CFR 1.313(c)(2) FOR
WITHDRAWAL FROM ISSUE

Applicants hereby petition for withdrawal from issue of the above identified
application under the provisions of 37 CFR 1.313(c)(2), and state the following:

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*
*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(a)

37 C.F.R. 1.10*

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TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: _____

Signature _____

CLIFFORD J. MASS

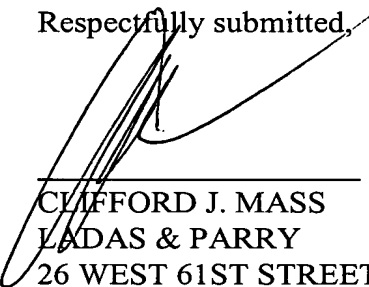
(type or print name of person certifying)

***WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail"
mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label
thereon is an oversight that can be avoided by the exercise of reasonable care, request for
waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed.
Reg. 56,439, at 56,442.

06/15/2004 AKELLEY 0000001 10056233 130.00 DP 01 FC:1460

1. The issue fee in this matter was paid on April 22, 2004.
2. A Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 is annexed hereto along with an Information Disclosure Statement.
3. The Information Disclosure Statement calls attention to a reference which was cited in a corresponding foreign application. Withdrawal from issue is requested in order for the Examiner to consider the RCE and Information Disclosure Statement.
4. Attached hereto is a check for \$130.00 to cover the petition fee. Please charge any additional fee that may be required to Account 12-0425.

Respectfully submitted,



CLIFFORD J. MASS
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